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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,176	02/09/2004	Shaun T. Mesher	355-8	6755
20212	7590	09/24/2007	EXAMINER	
Lambert Intellectual Property Law Suite 200, 10328 - 81 Avenue Edmonton, AB T6E 1X2 CANADA				METZMAIER, DANIEL S
ART UNIT		PAPER NUMBER		
1712				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/773,176	MESHER ET AL.	
	Examiner	Art Unit	
	Daniel S. Metzmaier	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 June 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,10,14,16,17 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 14,16 and 17 is/are allowed.
- 6) Claim(s) 1,10 and 30-36 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claims 1, 10, 14, 16-17, and 30-36 are pending.

Claim interpretation

1. The terms "aqueous acid" referred to in claim 8 has been interpreted as the acid and water. The ketones, esters, and cyclic ethers that have been limited to a carbon number range are interpreted as the total carbons in the respective ketones, esters, and cyclic ethers.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1,10 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins, US 4,737,296.

Watkins (column 7, lines 33-36; column 8, lines 6-10, 26-32, 51-52, 66 to column 9, line 1; column 9, lines 45) discloses the formation of acid-containing foams for the purpose of cleaning scale out of conduits. Watkins (column 7, line 36) clearly contemplates mixtures of solvents.

Watkins (column 8, lines 6 et seq) clearly contemplates alcohols, esters and ketones as claimed.

Watkins differs from the claims in the use of a particular combination of solvents and the concentrations thereof.

Watkins (column 7, lines 33-36; column 8, lines 6-10, 26-32, 51-52, 66 to column 9, line 1) contemplates mixtures of solvents including those instantly claimed. Watkins (example 16) discloses the use of MEK at about 22 vol% and about 74 vol% acid. The vol% is referenced for simplicity and the wt% of the materials would not vary dramatically therefrom since the materials would have been expected to have specific gravities of about 1.

It is generally *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); *In re Crockett*, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, the ester, ether, and alcohol solvents are all taught for the same function

as a mutual solvent of the oil and water. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the mixtures in an acid-containing composition for the advantage of matching the solvent system to the system, e.g., sludge and scale, being treated.

The specification does not provide a showing of criticality of the particular solvents and each is specifically recited in the Watkins reference.

Allowable Subject Matter

5. Claims 14 and 16-17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.
6. While Watkins discloses ethers, Watkins lacks an adequate teaching of THF as suitable ether. It is deemed that only with impermissible hindsight would the ordinary skilled artisan select THF from the generic ethers listed on the Watkins reference.

Response to Arguments

7. Applicant's arguments filed 29 June 2007 have been fully considered but they are not persuasive.
8. Applicants assert the claims are not indefinite in light of the amendments inserting an aqueous acid and the term carries the full range of the acid component.
9. Applicants assert the amendment turns the claims back to their form after the Office Action of 15 Nov. 2005. Applicants assert the claims exclude the foaming components of the Watkins reference. This has not been deemed persuasive. Applicants claims immediately after the Office Action of 15 Nov. 2005 are different than

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now claimed. Applicant has the burden of showing that the foaming agents materially affect the compositional properties. Applicants have not met their burden.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Daniel S. Metzmaier
Primary Examiner
Art Unit 1712**

DSM